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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,120	12/28/2000	Dean A. Seifert	FDC 0125 PUS	6714

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01/25/2007

EXAMINER

KAZIMI, HANI M

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/751,120

Applicant(s)

SEIFERT ET AL.

Examiner

Hani Kazimi

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/8/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This communication is in response to the Information Disclosure Statement IDS filed on November 8, 2006. Claims 1-13 are pending. The rejections cited are as stated below:

### ***Summary of this Office Action***

2. Applicants' amendment and arguments filed on March 20, 2006 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 1-13 are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

### ***Response to Applicants' Amendment***

3. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of (United States Patent Number 6,488,203).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claims 1-13 essentially repeat all the features listed in the Patents listed above,

Art Unit: 3691

such as transferring money between a sender and a recipient includes the receipt of identifying information provided by the recipient, compare that information with transaction information stored on a host computer, providing a code if the identifying information matches the information stored on the computer of the sender, receiving the code information at the host computer from a dispensing terminal, allowing funds to be transferred by the dispensing terminal if the code is verified.

Claims 1-13, further recite the additional use of a kiosk agent, which does not appear in the claims of the above-mentioned Patent.

However, Shafiee et al. (United States Patent Number 6,771,766 B1) teach the use of live agents at kiosks in order to assist customers to complete transactions (column 2, lines 9-23).

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to use live agents at a kiosk in order to assist a customer to complete a transaction, because it greatly improves the efficiency of the system and provides the user with assistance in conducting transactions, and a system that is user friendly.

Claims 1-13, further recite the additional use of different forms of security codes such as an image, sound, or the step of scanning the security code, which does not appear in the claims of the above-mentioned Patent.

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to use security code in the form of an image, sound, or a barcode for scanning, because it enhances operational efficiency, capturing data is faster and more accurate, mistakes are minimized, and provides the user with a system that is more

efficient and user friendly.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375.

4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

#### ***Claim Rejections - 35 USC 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (United States Patent Number 5,963,647) in view of Shafiee et al. (United States Patent Number 6,771,766 B1), hereinafter, "Shafiee".

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (United States Patent Number 5,963,647) in view of Shafiee et al. (United States Patent Number 6,771,766 B1), hereinafter, "Shafiee" as discussed in paragraph 9 of the previous office action mailed on September 20, 2005.

Further: Claims 10-13, Downing teaches that the security code comprises a symbol (column 3, lines 12-30). Downing fails to teach that security code comprises an image, sound, or the step of scanning the security code.

Official Notice is taken that security codes in the form of image, sound, or barcode that is scanned is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time Applicant's invention was made to modify the teachings of Downing to include a security code in the form of an image, sound, or a barcode for scanning, because it enhances operational efficiency, capturing data is faster and more accurate, mistakes are minimized, and provides the user with a system that is more efficient and user friendly.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-13 have been fully considered but are not deemed to be persuasive. Applicant argues in substance that;

a) The double patenting is improper, "... none of the claims of the '203 patent recite use of both a unique personal identification number and security code. Furthermore, although each method claim of the '203 patent recites use of a code that corresponds to transaction details stored on a data base, each method claim further recites that "the code is not provided by or to the recipient for use by the recipient during the send transaction."

b) The examiner failed to show a proper motivation for the combination. In that regard, the '647 patent actually teaches away from use of a kiosk station having a live agent as taught by the '766 patent. More specifically, the '647 patent teaches the use of a customer-activated terminal (CAT), automated teller machine (ATM), or a personal computer that is configured to operate as a CAT. (See Fig. 2 of the '647 patent.). The combination failed to teach the steps receiving cash at the initiating terminal corresponding to the designation of an amount of funds, reading a stored value card at the initiating terminal, and a scanning device.

In response to a):

Examiner agrees with Applicant that none of the claims of the '203 patent recite the use of both a unique personal identification number and a security code, which is recited in the claims of the present application. However, the double patenting rejection is an obvious type double patenting, and the use of a unique personal identification number and a security code is taught by the Downing reference (see above rejections). With respect to the claimed limitation in the '203 "the code is not provided by or to the recipient for use by the recipient during the send transaction", which is not claimed in the present application. The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375.

In response to b):

The fact that the '647 patent teaches the use of a customer activated terminal (CAT), automated teller machine (ATM), or a personal computer that is configured to operate as a CAT is not an indication that the reference teaches away from the use of a kiosk station having a live agent. As mentioned in the previous and present office action and included in the motivation statement of combining the references, Downing supports the concept of providing assisted transactions (Downing, column 5, lines 40-46). In response to Applicant's argument that the references fail to show the steps receiving cash at the initiating terminal corresponding to the designation of an amount of funds, reading a stored value card at the initiating terminal. Both of these



steps can be performed an ATM machine, which is disclose by Downing. The scanning device is clearly taught by the secondary reference Shafiee (column 2, line 9-23, column 5, lines 57-64, and column 14, line 32 thru column 15, line 21).

### ***Conclusion***

9. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

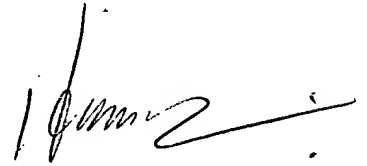
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



HANI M. KAZIMI  
PRIMARY EXAMINER

Art Unit 3624

January 19, 2007